



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,621	12/03/2004	Tatsuo Tsuneka	SAE-036	5295

20374 7590 08/09/2005

KUBOVCIK & KUBOVCIK  
SUITE 710  
900 17TH STREET NW  
WASHINGTON, DC 20006

EXAMINER
----------

HUANG, MEI QI

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/516,621	Applicant(s) TSUNEKA ET AL	
	Examiner Mei Q. Huang	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/01/05, 06/22/05</u> | 6) <input type="checkbox"/> Other: _____  |

41

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ashihara et al. (US Patent 6,277,912).

The prior art to Ashihara et al. provides an aqueous, chlorinated modified polyolefin-based resin composition and its manufacture. The aqueous chlorinated polyolefin is modified by  $\alpha$ ,  $\beta$ -unsaturated carboxylic acid and/or its acid anhydrides, for example, maleic acid, maleic anhydride, citraconic acid, citraconic anhydride, itaconic acid, and itaconic anhydride (column 7, line 66, to column 8, line 2) and neutralized with an organic or inorganic basic substance (column 5, lines 9-11).

In regard to claim 2, the emulsion of the aqueous, chlorinated modified polyolefin-based resin composition containing isotactic polypropylene as a main component is shown at column 7, lines 4-7. The  $\alpha$ ,  $\beta$ -unsaturated carboxylic acid modifier is used in an amount of 0.01-60 wt% (column 6, lines 16-17).

In regard to claims 3-4, chlorination of the chlorinated modified polyolefin is in the range, preferably, of 10-40 wt% (column 8, line 50-56), which covers the instantly

Art Unit: 1713

claimed range of 15-35 wt%. The weight-average molecular weight of the modified chlorinated polyolefin polymer, i.e. 1,000-3000,000, is described at column 7, lines 14-15, , which covers the instantly claimed range of 10,000-150,000.

As to claim 5, the basic substances used for neutralization of the modified chlorinated polyolefin are disclosed at column 10, lines 44+, wherein the amine compounds can be seen.

In sum, all the limitations of claims 1-5 are fully met by Ashihara et als' disclosure.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashihara et al. (US Patent 6,277,912) in view of Verardi et al. (US Patent 5,863,646).

Art Unit: 1713

The prior art to Ashihara et al. is adequately presented above in this Office Action and is incorporated herein by reference. Ashihara et al.'s disclosure at column 13, Example 1, teaches the procedure of preparing the modified chlorinated polyolefin which includes dissolving the modified chlorinated polyolefin in an organic solvent (column 13, line 30), adding water for dispersion (column 13, line 45), neutralizing the pre-emulsion (column 13, line 57), and evaporating the solvent (column 13, line 59-60). The difference between the method of preparing the aqueous rein dispersion composition disclosed by Ashihara et al. and that claimed by the applicant is that the process step sequences are different, i.e. Ashihara et al. neutralize the dispersion after water is added. However, since applicant has not demonstrated the criticality of the process sequence, the selection of any order of performing process step is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). See MPEP §§ 2144.04.

Another difference between the prior art and the present application is that the organic solvent used by Ashihara et al. is an aromatic solvent, not the ethereal solvent as required by the present application.

The prior art to Verardi et al. discloses a liquid coating composition comprising chlorinated polyolefin which is grafted with maleic acid or anhydride (Abstract and column 3, line 53-54) having a weight-average molecular weight of 5,000-200,000 (column 3, lines 3-4). The chlorine content of the chlorinated polyolefin is preferably 10-30 wt% (column 3, lines 63-64). The polyolefin is neutralized with an amine (column 4, lines 3-4). The coating composition can be either water-based or solvent-based.

Art Unit: 1713

Examples of the solvent include aromatic solvents, such as toluene, xylene; and ethereal solvents, such as propylene glycol monomethyl ether (column 6, lines 41-54). Verardi et al. herein teach the interchangeability of aromatic solvent, such as toluene, and ethereal solvent, such as propylene glycol monomethyl ether, as functionally equivalent organic solvent in a substantially identical aqueous, modified chlorinated polyolefin-based resin dispersion composition. Thus, it would have been obvious to one of ordinary skill in the art to replace xylene with ethereal solvent, as taught by Verardi et al. in Ashihara et als' aqueous chlorinated modified polyolefin-based resin composition based on their expected interchangeability as functionally equivalent organic solvent, motivated by a reasonable expectation of success. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

As to claim 7, the rejection made for claim 2 described previously in this Office Action would be applied herein to reject claim 7.

As to claims 8-9, the rejection made for claims 3-4 described previously in this Office Action would be applied herein to reject claims 8-9.

As to claim 10, Verardi et als' teaching of the ethereal solvents, such as propylene glycol monomethyl ether, can be seen at column 6, lines 53-54.

As to claim 11, the rejection made for claim 5 described previously in this Office Action would be applied herein to reject claim 11.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mei Q. Huang whose telephone number is (571) 272-3549. The examiner can normally be reached on 8am - 4pm, Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mei Q. Huang  
Examiner

August 3, 2005



DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
ELECTRONIC BUSINESS CENTER 1700